

REMARKS

Claims 6-8, 14 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Asao et al. (JP '834; hereafter, “Asao”) in view of Nakatsuka et al. ‘185 (“Nakatsuka”). Claims 6 and 8 are independent. This rejection is respectfully traversed for the following reasons.

A. Neither Asao nor Nakatsuka, alone or in combination, disclose or suggest identification information carrying information about the type and composition of the solder

Claims 6 and 8 each recite in pertinent part, “said identification information carrying information about the type and composition of the solder.” The Examiner admits that Asao does not have identification information which carries information about the type and composition of the solder. The Examiner therefore relies on the Abstract of Nakatsuka as allegedly teaching such information. The Examiner’s reliance on Nakatsuka is not understood.

The relied on portion of Nakatsuka is completely silent as to marking products to identify the type and/or composition of solder contained in the product. Nakatsuka merely discloses lead-free solder compositions *per se*, but does not suggest marking the product in which the disclosed solder is used to identify the type and/or composition of the solder. At best, the cited prior art may, for argument’s sake, suggest using the lead-free solder compositions taught by Nakatsuka in the products disclosed by Asao; but, the cited prior art does not suggest modifying the bar codes of Asao so that they carry information about the type and/or composition of the solder. Indeed, it appears that Nakatsuka is completely silent as to identifier-markings on products, let alone suggest markings that specifically identify the type and/or composition of the solder.

The Examiner has offered no evidence *from the prior art* that discloses or suggests an article having identification information which carries information about the type and/or composition of the solder. Indeed, only Applicants' specification discloses such a feature and the motivation for providing it within the particular combination recited in the claims.

B. Neither Asao nor Nakatsuka, alone or in combination, disclose or suggest identification information indicating presence of lead when the article or housing contains lead

With respect to this issue, the Examiner asserts that Applicants' arguments filed on December 27, 2004 are "gratuitous since Sn, Bi, ... are not claimed." However, Applicants never argued that Sn, Bi, ..., are claimed elements of the present invention. Rather, Applicants are trying to illustrate to the Examiner why Asao's bar code is not *lead* identification information. Asao's bar code identifies heavy metal content, and the Examiner has improperly interpreted heavy metal as if it embodied only lead. This is clearly incorrect. Lead is just one type of heavy metal. Heavy metals include Sn, Bi, Au, Ag, etc.. Accordingly, when Asao's bar code indicates that the article contains heavy metal, this does NOT necessitate that the article contains lead.

If the Examiner maintains this position, in order to clarify issues on the record for a possible appeal to the Board, the Examiner is respectfully requested to answer this question: if Asao's bar code indicates heavy metal is contained in the article, does this mean that lead is contained in the article? It appears that the Examiner's answer to this question is "yes" in view of the Examiner's continued position that Asao discloses "lead identification information." Indeed, the Examiner's answer would have to be "yes" to take the position that he has taken.

In contrast, it is Applicants' position that if Asao's bar code indicates heavy metal is contained in the article, such indication does not mean that lead *must* be contained in the article. Indeed, if Asao's bar code indicates heavy metal is contained in the article, it is quite possible that no lead is contained in the article (e.g., heavy metal contained in article may simply be Sn, Bi, Au, and/or Ag, *without* lead). Accordingly, Asao's bar code does not indicate lead information *specifically* as recited in the claims. The Examiner is reminded that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999).

C. Neither Asao nor Nakatsuka, alone or in combination, disclose or suggest that the housing carries the lead identification information

In addition, with respect to claim 8, the cited prior art further does not disclose or suggest that the *housing* carries the lead identification information. Rather, the bar code of Asao is attached on the surface of the printed board. To overcome this deficiency of Asao, the Examiner merely alleges that it would have been obvious to have the bar code of Asao "imprinted on the housing which accommodates the printed circuit boards or articles" However, the Examiner has not provided any prior art to support this allegation. Instead, the allegation is based entirely on improper hindsight reasoning. The Examiner has offered no prior art that discloses or suggests the aforementioned feature, and simply concludes such a feature is obvious based on the Examiner's own opinion. Indeed, only Applicants' specification discloses such a feature and the motivation for providing it within the particular combination recited in the claims.

The Examiner cites *In re McLaughlin* on page 6 of the outstanding Office Action as support that hindsight is sometimes proper. However, *In re McLaughlin* is not relevant to the instant case. As set forth in MPEP § 2145(X)(A), *In re McLaughlin* suggests that some

hindsight may be proper as it pertains to the rationale *for combining references*. That is, if two references disclose all of the claim limitations, then there may be instances where the rationale to combine those references to reach the claimed invention may sometimes depend on some manner of hindsight.

In re McLaughlin does not support the position that limitations which are completely missing in the prior art can nonetheless be held to be obvious. *In re McLaughlin* therefore can not be relied on as a substitute to prior art for alleging obviousness of a limitation not otherwise disclosed in the prior art. In the instant case, the Examiner has improperly used *In re McLaughlin* as a substitute to prior art. That is, the Examiner has not produced prior art which discloses a **housing** that carries the lead identification information, so that the holding of *In re McLaughlin* is not relevant to, and can not be relied on in, the present case.

Moreover, the present invention as recited in claim 8 can provide advantages over the device of the cited prior art. For example, Asao requires the electrical appliance to first be disassembled before recognizing the bar code, and is therefore subject to the cost/delay required to do so; whereas the identification information of the present invention can be checked without the cost/delay associated with disassembling the electrical appliance in the middle of, for example, a recycling process.

If the Examiner maintains this rejection, pursuant to MPEP § 2144.03(C), Applicants hereby challenge the Examiner's allegation that it would have been obvious to have the lead identification information of Asao carried on the housing, **and respectfully request documentary evidence of his findings.**

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the claims because the prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Withdrawn independent claims 11 and 12 are submitted to be patentable for at least the reasons discussed above regarding claim 8. Accordingly, the Examiner is respectfully requested to reconsider the withdrawal of claims 11-13.

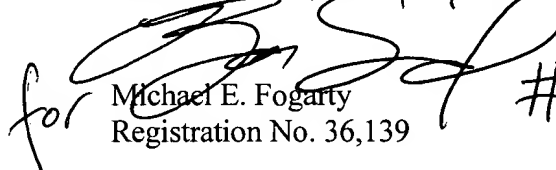
CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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